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09/769,142	01/25/2001	Spencer A. Rathus	660-023	8426

7590

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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,142

Applicant(s)

RATHUS ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 168-289 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 168-289 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Preliminary Amendment filed 25 January 2002.

### *Claim Objections*

2. Claims 183 and 185 are objected to because of the following informalities:

Re claim 183, line 2: Substitute "ISDN" with -- integrated service digital network (ISDN) --.

Re claim 185, line 2: Substitute "CATV" with -- cable television (CATV) --.

Appropriate correction is required.

### *Provisional Obviousness-Type Double Patenting*

3. Claims 168-220, 242-245 and 253-289 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of copending Application No. 09/769,149 (hereinafter '149).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 168-220, 242-245 and 253-289 of the instant application, Applicants claim a system for **displaying programming** to a user, the system comprising "a **printed photograph** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said feature and a **means for transmitting a coded signal** in response to the recognition of said feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material in response to receiving said coded signal", ... and "a **display unit** for presenting said programming material". The method of providing a user access to programming material,

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comprising the steps of **"imprinting a machine recognizable feature"**, **"scanning said machine recognizable feature"**, **"transmitting data associated with said machine recognizable feature"**. The '149 patent discloses a system for **displaying programming** to a user, the system comprising **"a printed stationery having at least one machine recognizable feature"**, **"a feature recognition unit having associated therewith a means for recognizing said feature and a means for transmitting a coded signal in response to the recognition of said feature"**, **"an intelligent controller having associated therewith a means for accessing said programming material in response to receiving said coded signal"**, ... and **"a display unit for presenting said programming material"**. The method of providing a user access to programming material, comprising the steps of **"imprinting a machine recognizable feature"**, **"scanning said machine recognizable feature"**, **"transmitting data associated with said machine recognizable feature"**. Although the scope of claims 168-220, 242-245 and 253-289 of the present application and claims 168-221, 224-263 of '149 application are almost identical, the difference between the present claimed invention and the '149 application is that the present claimed invention is a narrower recitation of the '149 application (e.g., the present claimed invention recites **"a printed photograph having at least one machine recognizable feature, etc."** whereby the '149 application recites **"a printed stationary having at least one machine recognizable feature, etc."**). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 168-221, 224-263 of '149 application as a general teaching for having a system for **displaying programming** to a user with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 168-169, 172, 174-175, 177-182, 184, 186-196, 199, 200, 210, 213-218, 220, 253-254, 256-258, 260-263, 267-273, 275, 278, 280, 282 and 284-289 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al (US 6,269,342) in view of Silverbrook (US 6,353,772 B1).

Re claims 168-169, 172, 174-175, 177-182, 184, 186-196, 199, 200, 210, 213-218, 220, 253-254, 256-258, 260-263, 267-273, 275, 278, 280, 282 and 284-289: Brick et al discloses a system for displaying programming to a user, the system comprising printed stationery having at least one machine recognizable feature 342 (fig. 10); a feature recognition unit 80 (fig. 9) having a means 356 (fig. 10) for recognizing the feature 342 and a means [338A, 358A] (fig. 10) for transmitting a coded signal in response to the

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recognition of the feature 342; an intelligent controller 334 (fig. 10) having a means for accessing the programming material in response to receiving the coded signal; and a display unit 362 (fig. 10) for presenting the programming material (see figs. 9 and 10; col. 9, line 1 through col. 12, line 67; and col. 13, lines 35+).

Brick et al fails to teach or fairly suggest that the printed stationary is a printed photograph.

Silverbrook teaches the above limitation with printer 5 for printing user's photo image 6 (fig. 1-1; col. 5, lines 13+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Silverbrook into the teachings of Brick et al in order to provide Brick et al with a more user-friendly system wherein the user has a greater flexibility to print out his/her pictures/photographs in his/her own way of designing. Furthermore, such modification would have been an obvious extension as taught by Brick et al, and therefore an obvious expedient.

7. Claims 170-171, 173, 176, 198, 201, 203-204, 206, 208-209, 211-212, 219, 242-252, 255, 259, 264-265, 276-277 and 279 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al as modified by Silverbrook as applied to claim 168 above, and further in view of Rhoads (US 6,311,214). The teachings of Brick et al as modified by Silverbrook have been discussed above.

Re claims 170-171, 173, 176, 198, 201, 203-204, 206, 208-209, 211-212, 219, 242-252, 255, 259, 264-265, 276-277 and 279: Brick et al/Silverbrook have been discussed above but fail to teach or fairly suggest that the data link comprising image/video/sound data link and the machine-readable feature comprises a digital watermark.

Rhoads teaches the above limitation with the data link comprising image/video/sound data link (col. 22, lines 1+); and the machine-readable feature comprises a digital watermark (col. 13, lines 5-40); also see figs. 1-2 and col.2, line 64 through col. 4, line 46; col. 8, line 8 through col. 10, line 59; col. 14,

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line 55 through col. 15, line 13; col. 18, lines 30+; col. 19, line 65 through col. 20, line 49; col. 22, lines 1+; col. 34, lines 5+; col. 36, lines 46+.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Rhoads into the teachings of Brick et al/Silverbrook in order to provide Brick et al/Silverbrook with the latest technology, providing the user/operator with a clearer information data displayed. Furthermore, such modification would have provided the user/operator flexibility in selecting a desired format of previewing data. Moreover, such modification would have been an obvious extension as taught by Brick et al/Silverbrook for aesthetic purpose (i.e., digital watermark machine-readable feature), well within the ordinary skill in the art, and therefore an obvious expedient

8. Claims 183, 185, 197, 202, 205, 207, 266, 274 and 283 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al as modified by Silverbrook as applied to claim 168 above, and further in view of Reber et al (US 5,995,105). The teachings of Brick et al as modified by Silverbrook have been discussed above.

Re claims 183, 185, 197, 202, 205, 207, 266, 274 and 283: Brick et al/Silverbrook have been discussed above but fails to teach or fairly suggest that the machine-readable feature is invisible; the data link comprising an integrated service digital network, a cable television line; and the display having a pager.

Reber et al teaches the above limitation with an invisible machine-readable barcode (col. 4, lines 41-45); the data link comprising an ISDN, cable television system (col. 5, lines 14+ and col. 9, lines 20+); and the system having a two-way pagers (col. 3, lines 66+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Reber et al into the teachings of Brick et al/Silverbrook in order to

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provide Brick et al/Silverbrook with the latest technology for a more accurate and faster system due to the benefit of ISDN networking line. Furthermore, such modification would have provided Brick et al/Silverbrook with a more secure system via invisible machine-readable feature. Moreover, such modification would have been an obvious extension as taught by Brick et al/Silverbrook with a more user-friendly system due to the system's properties (i.e., faster, more accuracy and more secure), well within the ordinary skill in the art, and therefore an obvious expedient.

9. Claims 221-241 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al as modified by Silverbrook as applied to claim 168 above, and further in view of Yukihiro (JP 11-355,699). The teachings of Brick et al as modified by Silverbrook have been discussed above.

Re claims 221-241, Brick et al/Silverbrook have been discussed above but fails to teach or fairly suggest the photograph information.

Yukihiro teaches the above limitation with the photograph information (see English detail description).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Yukihiro into the teachings of Brick et al/Silverbrook in order to provide Brick et al/Silverbrook with a more user-friendly system wherein the user can retrieve his/her desired photograph readily by inputting the photograph identification information (e.g., photographer, place, date and time information, etc.). Furthermore, such modification would have been an obvious extension as taught by Brick et al/Silverbrook, and therefore an obvious expedient.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The patents to Ono et al (US 5,027,196); Banks et al (US 5,559,714); Cannon et al (US 5,751,590); Tackbary et al (US 5,555,496); Suzuki (US 4,812,879); Coco et al (US 6,331,864); Kara (US 5,801,944); Davidson et al (US 5,615,123); Sato et al (US 6,064,832); Yokonuma et al (US 6,072,186); Kazami (US 5,493,355); Danby et al (US 5,551,011); Satoh et al (US 5,302,990); Mase (JP 7-64169); Ozaka (JP 6-233,159); Nonaka et al (JP 60-46684); and Abe (JP 62-98334) are cited as of interest and illustrate a similar structure to a method and apparatus for accessing electronic data via a familiar printed medium.

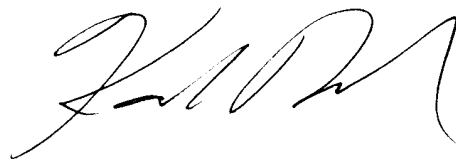
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Uyen-Chau N. Le

June 3, 2002



KARL D. FRECH  
PRIMARY EXAMINER